

Form paragraph 7.31.02 should be used when it is the examiner's position that nothing within the scope of the claims is enabled. In such a rejection, the examiner should explain all the reasons why nothing within the scope of the claim is enabled. To make sure all relevant issues are raised, this should include any issues regarding the breadth of the claims relative to the guidance in the disclosure.

¶ 7.31.02 Rejection, 35 U.S.C. 112, 1st Paragraph: Enablement

Claim [1] rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. [2]

Examiner Note:

1. This rejection must be preceded by form paragraph 7.30.01 or 7.103.
2. If the problem is one of scope, form paragraph 7.31.03 should be used.
3. In bracket 2, identify the claimed subject matter for which the specification is not enabling along with an explanation as to why the specification is not enabling. The explanation should include any questions the examiner may have asked which were not satisfactorily resolved and consequently raise doubt as to enablement.
4. Where an essential component or step of the invention is not recited in the claims, use form paragraph 7.33.01.

Additionally, in the previous Office Action Response mailed December 3, 2002, the Applicant requested further clarification in response to the Examiner specifically rejecting claims 2, 19-20, and 22-23 under 35 U.S.C. § 112, first paragraph, stating, "Applicant is also unsure as to which features of claims 2, 19-20, and 22-23 that the Examiner claimed were not described in the specification. Applicant contends that relevant features of claims 2, 19-20, and 22-23 have been described in the specification to allow one skilled in the art to practice the invention. Therefore Applicant requests that the rejection of claims 2, 19-20, and 22-23 under 35 U.S.C. § 112, first paragraph, be withdrawn."

Furthermore, the Applicant respectfully maintains that the elements of the claims are described in the specification, as the claims as originally filed are considered to be part of the disclosure. *See, e.g.,* MPEP, Eighth Edition, August 2001, §608.01(I)

608.01(I) Original Claims

In establishing a disclosure, applicant may rely not only on the description and drawing as filed but also on the original claims if their content justifies it.